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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/612,307
Filing Date: July 02, 2003
Appellant(s): MEYER ET AL.

Mark G. Meyer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 31, 2007 appealing from the Office action mailed April 17, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.
The brief identifies Scientific Game International Inc. as the real party of interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.
Claims 1-42 are pending and are rejected. Appellants appeal the final rejection of claims 1-42.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.
The amendment after final rejection filed on August 20, 2007 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) New Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed upon appeal is substantially correct. The changes are as follows: Claim(s) 1-29 and 35-41 are rejected under 35 USC 101 as being directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Powerball	www.powerball.com	June 23, 2003
Walker et al.	US 6,497,408 B1	December 24, 2002
"FAQK"	http://conjelco.com/fag/keno.html	December 03, 1998

(9) Grounds of Rejection

NEW GROUND(S) OF REJECTION

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claim(s) 1-29 and 35-41 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Bilski* (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101.

Claims 1-12, 14-16, and 18-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.Powerball.com in view of Walker et al (US 6,497,408).

Regarding claims 1-4, 35, 36, 38, and 41:

Powerball teaches receiving a plurality of player symbol selections from a plurality of numerical possibilities (Powerball Page 3), presenting the player with a ticket identifying the player symbol selections in response to placing of a wager by the player selections from said plurality of numerical possibilities and awarding a prize dependent on the number of corresponding player symbol selections and winning symbol selections (Powerball Page 3 & Page 1 "Powerball prizes and Odds"), and notifying the player of information related to the payout (Powerball Page 3 Paragraph 1). The claimed multidimensional lookup table based on the respective number of symbols in each set of player symbols is shown on the top of the first page of Powerball. Said table

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also demonstrates that some of the value payouts (i.e. two matched numbers plus the powerball has a \$7 associated prize) are less than the sum of the individual payouts (i.e. two distinct matched occurrences of a single number with the occurrence of a powerball has $2 \times \$4 = \8 prize). This indicates that the player does obtain a value payout different from the sum of the plurality of value payouts (which is the applicant's concern). While also demonstrating that a portion of the value payouts (i.e. four matched numbers plus the powerball has a \$5,000 associated prize) are greater than the sum of the individual payouts (i.e. an occurrence of four matched number and the separate occurrence of a powerball has a $\$100 + \$3 = \$103$ prize). Powerball is silent regarding the inclusion of multiple player sets, however in a related publication Walker teaches the purchase of multiple sets of numbers (player symbols) for a lottery (Walker Col 1:35-41). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the ability to purchase multiple sets of numbers as taught by Walker into the teachings of Powerball in order to allow an individual multiple chances to win in a game.

Regarding claims 5 and 10:

Powerball teaches calculating a payout for each set/entry hence constituting a base payout comprising the sum of individual payouts as so claimed.

Regarding claims 6-8 and 18-19:

Powerball/Walker teaches player purchasing of multiple sets (tickets) and as such they would implicitly have winning symbols capable of overlapping multiple sets in only a single occurrence of said winning symbol in addition to the awarding of the greatest

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available prize when multiple prizes are won. In this instance for an individual playing Keno and placing two separate wagers on a single selection of the same number the base game prize and the prize as determined through the summation of winning symbols will be the same amount. (Powerball; Match 5 Bonus Prize section)

Regarding claims 9:

Powerball teaches the awarding of a maximum individual payout per set through only awarding the highest paying combination as shown on the top of the first page of Powerball.

Regarding claims 11-12:

Powerball teaches a fixed player and winning set size and hence a fixed set size for multiple sets as so claimed (Powerball Page 3 First full paragraph).

Regarding claims 14-16:

Powerball/Walker teach the association of a fixed ticket price with each player set as such the limiting in number of player sets is implicitly determined based on the amount of the player wager.

Regarding claims 20-22, and 37:

though teaching a selection process for the selection of the winning numbers (symbols) Powerball in view of Walker may arguable considered silent to the process of winning number selection including random selection, pseudo- random selection, and the random selection of objects associated with winning symbols, however the applicant admits that such features are old and well known in the art in paragraphs 2 and 3 of their specification. Therefore it would have been obvious to one of ordinary skill in the

art at the time of invention to incorporate the selection processes set forth above in the invention of Powerball/Walker in order to provide a non-biased set of winning numbers.

Regarding claim 23:

Walker teaches the inclusion of processor pseudo-random symbol selections (Walker Col 1:43-46), however is silent regarding the use of such selections for use as a winning set. It would have been obvious to one of ordinary skill in the art at the time of invention to utilize the automated selections of Walker in the device of powerball to determine game outcome in order to avoid mechanical tampering or defect.

Regarding claims 24, 25, 39, and 40:

Walker teaches the selection of six number from a pool of forty-two (Col 2:20-23) wherein the absence of ball replacement would prevent the same symbol from being reselected. Further the occurrence of redundant numbers in his example would be inconsistent with the odds presented on line twenty-three. It would have been obvious to limit each number to a single selection and hence exclude previously selected prize numbers to maintain desired odd and or payout in the teaching of Powerball. Powerball, moreover, teaches presenting the player with a ticket identifying the player symbol selections in response to the placing of a wager by the player (Powerball Page 3 "purchase a ticket"), receiving a plurality of player symbol selections from a plurality of numerical possibilities (Powerball Page 3), selecting a plurality of winning symbol selections from said plurality of numerical possibilities and awarding a prize dependent on the number of corresponding player symbol selections and winning symbol selections (Powerball Page 3 & Page 1 "Powerball prizes and Odds"), and notifying the

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player of information related to the payout (Powerball Page 3 Paragraph 1). The claimed multidimensional lookup table based on the respective number of symbols in each set of player symbols is shown on the top of the first page of Powerball. Said table also demonstrates that some of the value payouts (i.e. two matched numbers plus the powerball has a \$7 associated prize) are less than the sum of the individual payouts (i.e. two distinct matched occurrences of a single number with the occurrence of a powerball has $2 \times \$4 = \8 prize). This indicates that the player does obtain a value payout different from the sum of the plurality of value payouts (which is the applicant's concern). While also demonstrating that a portion of the value payouts (i.e. four matched numbers plus the powerball has a \$5,000 associated prize) are greater than the sum of the individual payouts (i.e. an occurrence of four matched number and the separate occurrence of a powerball has a $\$100 + \$3 = \$103$ prize). Powerball is silent regarding the inclusion of multiple player sets, however in a related publication Walker teaches the purchase of multiple sets of numbers (player symbols) for a lottery (Walker Col 1:35-41). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the ability to purchase multiple sets of numbers as taught by Walker into the teachings of Powerball in order to allow an individual multiple chances to win in a game.

Regarding claims 26-29:

Walker teaches the use of "quick pick" for providing a random automated selection of player symbols (Col 1:43-46) in addition to the previously provided for player selection and ability to purchase multiple tickets. It would have been obvious to one of ordinary

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skill in the art at the time of invention to have allowed to purchase the number of tickets (sets of symbols) through either selecting the numbers manually or alternatively opting for a an automated selection to give the user the ability to blend a perceived skill game and a game of chance as they see fit.

Regarding claims 30-34, and 42:

Walker teaches the use of a networked lottery system for receiving a player's wager, receiving the player's symbol selection, and notifying the player of payout data, on remote computing device including personal and lottery terminal type devices (Walker Figures 1,7,8 and Col 5:23-25,). It would have been obvious to one of ordinary skill in the art at the time of invention to have utilized a networked computing system such as the one taught by Walker in the invention of Powerball/Walker as a the game distribution means in order to increase game availability. To answer the applicant's concern, the claimed multidimensional lookup table based on the respective number of symbols in each set of player symbols is shown on the top of the first page of Powerball. Said table also demonstrates that some of the value payouts (i.e. two matched numbers plus the powerball has a \$7 associated prize) are less then the sum of the individual payouts (i.e. two distinct matched occurrences of a single number with the occurrence of a powerball has $2 \times \$4 = \8 prize). This indicates that the player does obtain a value payout different from the sum of the plurality of value payouts (which is the applicant's concern). While also demonstrating that a portion of the value payouts (i.e. four matched numbers plus the powerball has a \$5,000 associated prize) are greater then

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the sum of the individual payouts (i.e. an occurrence of four matched number and the separate occurrence of a powerball has a $\$100 + \$3 = \$103$ prize).

Claims 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over www.Powerball.com in view of Walker et al (US 6,497,408) in yet further view of Frequently Asked Questions about Keno (FAQK).

Regarding claims 13 and 17:

Powerball/Walker is silent regarding the inclusion of different symbols sized player sets however in a related teaching FAQK teaches the inclusion of various sized sets (Pages 1-2 chosen numbers). It would have been obvious to one of ordinary skill in the art at the time of invention to include various set sizes in a lotto game in order to allow for a greater number of smaller payouts.

(10) Response to Argument

Examiner respectfully disagrees with the Appellant's arguments for the following reasons:

In summary, Appellant argues that Powerball fails to disclose a method wherein the value payout for winning a plurality of sets on a single play is different than the sum of individual payouts for winning each set individually. Furthermore, that Walker fails to disclose winning a plurality of individual payouts of sets on a single play. **Appellant agrees that Walker does teach situations in which the value payout for the meta-game is different than the sum of a plurality of individual payouts for winning each set individually in the lottery game.**

The Examiner respectfully disagrees with assessment of the combination of Powerball in view of Walker. Walker discloses a value payout for a meta-game that is greater than or equal to a value payout for a winning set. For example, table 132 (FIG. 3) represents one embodiment of a price/award database 130 (Col. 9:32-36). As illustrated in table 132, the available award(s) 140, for the situation described above, include "\$7.27 or 140 credit points." One winning set of a group of twenty associated sets could have a value payout of \$2.50 and another winning set of the group could have a value payout of \$2.00, for example, and the combined total of the individual value payouts would be less than \$5.00. According to the example information in table 132, the award in such a circumstance could be \$7.27. Thus, the Walker '408 patent clearly discloses that in some embodiments a value payout for a meta-game (e.g., \$7.27) could be different than a value payout for a winning set (e.g., \$2.50).

In regards to the single play argument, Walker discloses determining a value payout for winning a plurality of entries on a **single play**, such as where more than one set of player numbers on a particular lottery ticket match some or all of the winning numbers for an associated lottery drawing. For example, the Background section describes an illustrative example in which if a player purchases five "quick-pick" sets of numbers, or entries, for a 6/49 Lotto drawing, a lottery terminal could randomly select five sets of six numbers and then print a **single** ticket listing the five sets of numbers (Col. 1:38-65). A player may purchase, during a **single transaction session**, a plurality of lottery drawing entries that are registered as a group (Col. 15:2-5). A plurality of entries (e.g., on a ticket) may be determined to be winners in the **same drawing**, and a

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corresponding value payout may be provided for winning the plurality of sets (e.g., the value payout may be the sum of the payouts for the respective awards for the individual winning sets). For example, a value payout for winning a plurality of sets on **a single play** in a specific lottery drawing could comprise $\$3 + \$3 + \$3 = \9 , where three sets win \$3 a piece (Col. 12:54- 57). **The claim language, specifically “a plurality of sets of player symbols associated with a player for a single play of a game” or “wherein, for at least some value payouts the value payout for winning a plurality of sets on the single play..”, only requires that the plurality of sets be associated with “single play” and the above with respect to Walker clearly illustrates these limitations.** The appellant argues that the meta-game of Walker is clearly a separate game from the set of lottery tickets. However, the term “meta” means after, beyond, or **with** and therefore meta-game can be interpreted as a game within a game or part of an overall game. Appellant argues, “that in order to be eligible to play the separate, supplemental meta-game, a player must register separately for the meta-game.” However, as disclosed above Walker discloses that the player purchases drawing entries and registers the entries as a group in one single transaction. Appellant argues that in order to win a different payout a player must participate in a second time in the meta-game. However, in combination with the above there is no evidence of a player actually playing a different game the meta-game simply acts as a bonus associated with the main game. Every aspect of the meta-game is based off of the single play of the primary lottery which is similar, if not, the basis of the appellants’ invention with respect to the independent claims. The player of Walker’s system purchases and registers a

group of entries prior to the single draw of the lottery and based on the results of the draw and the lottery group the player is eligible for an enhanced payout. In general, the meta-game/enhanced payout is part of the lottery game itself and the lottery game in its entirety is a single game. At least in this regards, Walker does not teach away from the claimed invention.

Appellant argues that Walker teaches a value payout in a separate meta-game that is based on losing or failing to reach a certain threshold of winning a plurality of sets in the primary lottery game. And a reference that teaches this teaches away from a gaming method that requires determining a value payout for winning a plurality of player set on a single play that is different from the sum of value payouts for winning each player set individually. In a further reading of Walker, Walker discloses that a player could qualify for the meta-game award so long as the total prize won by the primary lottery drawing entries of the group in the primary lottery does not exceed a certain threshold (Col. 12:35-45). This is actually contrary and opposite to the appellant's interpretation. In this embodiment, as long as the player doesn't win too much the player receives an additional award. Furthermore, Walker discloses that the threshold at which a player qualifies for a meta-game award may be **set at any prize or monetary level** by the meta-game sponsor or authority. For example, the meta-game threshold can be set at the top jackpot level (Col. 12:65-Col. 13:7) e.g. the player could win a payout for each and every individual entry and receive an additional different enhanced payout. At least due to the above, Walker does not teach away from such a limitation.

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At least in regards to the above, the combination of Powerball in view of Walker and in further view of FAQK (frequently asked questions about keno) teaches the appellant's invention with respect to the dependent claims 13 and 17.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

PRELIMINARY REMARKS

After further consideration, this application contains at least one claim that does not meet the patent eligibility requirement for statutory subject matter under 35 USC 101. Accordingly, this examiner's answer contains a new ground of rejection under 35 U.S.C. 101. Appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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